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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,860	12/15/2005	Eiko Yoshino	04783/030001	2352
22511	7590	11/16/2007	EXAMINER	
OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			VANCHY JR, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2624	
			NOTIFICATION DATE	DELIVERY MODE
			11/16/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/560,860	YOSHINO, EIKO	
	Examiner	Art Unit	
	Michael Vanchy Jr.	2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :05/24/2007, 03/08/2007, 12/15/2005.

## DETAILED ACTION

### *Drawings*

1. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Applicant is given a TWO MONTH time period to submit a drawing in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Luman et al., US 7,129,934 B2.**

**Regarding claim 1:**

Luman et al. (Luman) uses a plurality of touch-sensitive input/display tablets (terminal devices), which can include a predetermined drawing (background) that multiple users can mark up, with hand drawn markings, on the touch-sensitive tablets (col. 3, lines 7-21). These mark ups are placed on and around the drawing, which can be displayed back onto the tablets as well as being displayed through a projection means or CPU (Fig. 1).

**Regarding claim 2:**

Luman's tablets (terminal devices) can receive the background image data through wireless communication links (communication circuit), for example RF (col. 3, lines 42-46).

**Regarding claim 3:**

The terminal device according to claim 1, further comprising printing control means (Fig. 1, item "108" a computer for control means) for printing the background image on the medium in a printing device in accordance with the background image data (Fig. 1, item "110" and col. 4, lines 30-38).

**Regarding claim 4:**

The terminal device according to claim 3, wherein the printing control means (Fig. 1 computer "108") causes the printing device (Fig. 1 printer "110") to print the background image expanded or contracted in at least one direction (manipulate the drawings/markup images), in accordance with the region where the medium is placed in the handwriting input device (col. 4, line 61 to col. 5, line 7).

**Regarding claim 5:**

The terminal device according to claim 4, further comprising storage means (Fig. 3, items "329 and 330") that stores co-ordinate data whereby a correspondence is established between co-ordinates in the printing region in which the background image is printed on the medium and co-ordinates in a display region in which the background image is displayed by the display means, wherein the reproduction means displays the content of the handwritten notes superimposed on the displayed background image in accordance with the co-ordinate data (col. 5, lines 57-67).

**Regarding claim 6:**

The terminal device according to claim 4, wherein the printing control means (Fig. 1 computer "108") expands or contracts the background image in at least one direction in accordance with a region, on the medium, that is printable (manipulate the drawings/markup images) by the printing device (col. 4, line 61 to col. 5, line 7).

**Regarding claim 7:**

The terminal device according to claim 3, wherein the printing control means further causes the printing device to print a reference mark indicating the direction for placing the medium on the handwriting input device (Fig. 2, items "108 and 110" col. 4, lines 49-60, The examiner takes into account that a reference mark can easily be implemented through different "program modules" from the computer to "manipulate the drawings/markup images," discussed by Luman.).

**Regarding claim 8:**

A display system comprising: a first terminal device and a second terminal device constituting terminal devices according to claim 1 (Fig. 2); and a server connected through a communication circuit with the first terminal device and the second terminal device (Fig. 2, items "102 and 108" The examiner takes into account that the projector and computer work as servers in Luman's system.), wherein the first terminal device

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sends the background image data to the server through the communication circuit (col. 3, lines 11-14), the server sends the background image data received from the first terminal device to the second terminal device through the communication circuit, and the second terminal device displays the background image in accordance with the background image data received from the server (col. 3, lines 14-16).

**Regarding claim 9:**

The display system according to claim 8, wherein the second terminal device displays the background image when there is a request from the first terminal device to display the background image (col. 8, line 62 to col. 9, line 5).

**Regarding claim 10:**

The display system according to claim 8, wherein the first terminal device sends first handwritten data constituting the handwritten data received by the first terminal device to the server, the server sends the first handwritten data at least to the second terminal device, and the second terminal device displays the content of the handwritten notes indicated by the first handwritten data (Fig. 2 and col. 3, lines 7-21).

**Regarding claim 11:**

The display system according to claim 10, wherein the second terminal device sends second handwritten data constituting the handwritten data received by this second terminal device to the server, the server further sends the second handwritten data at least to the first terminal device, and the first terminal device further displays the content of the handwritten notes indicated by the second handwritten data (Fig. 2 and col. 3, lines 7-21, The examiner takes into account that writing from the many tablets discussed in Luman can be sent and displayed to each other through the projector. Thus, the first tablet can send to the second tablet, which can send back to the first or a third tablet and so on (col. 8, line 62 to col. 9, line 5).).

**Regarding claim 12:**



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A display system comprising a first terminal device and a second terminal device constituting terminal devices according to claim 1, wherein the first terminal device generates a synthesized image (collaborative markup projection system) including the background image and the content of the handwritten notes displayed superimposed on this background image to be sent to the second terminal device, and the second terminal device displays the synthesized image as the background image in the second terminal device (col. 3, lines 7-21, The examiner takes into account that since the markups can be collaborative, the image sent is thus synthesized based on additional markups coming from multiple tablets.).

**Regarding claim 13**, see rejection made to claim 1, as it addresses the rejection to the system of this computer program (Fig. 3 and col. 4, lines 49-60).

**Regarding claim 14**, see rejection made to claim 1, as it addresses the rejection to the system of this recording medium (Fig. 3 and col. 4, lines 49-60).

**Regarding claim 15**, see rejection made to claim 1, as it addresses the rejection to the system of this method (Fig. 3 and col. 4, lines 49-60).

### ***Examiner's Note***

The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).



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However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

### ***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Vanchy Jr. whose telephone number is (571) 270-1193. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm.

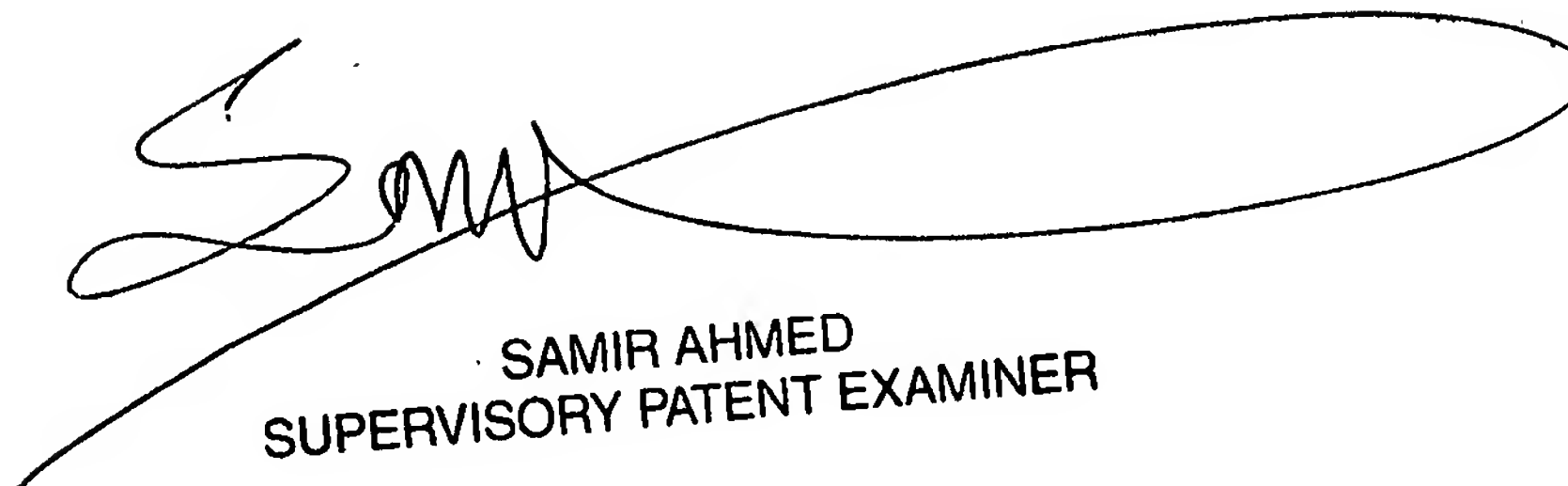
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached on (571) 272-7413. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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